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10/825,299	04/16/2004	Joseph H. Matthews III	003797.00923	7755

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WASHINGTON, DC 20005-4051

EXAMINER

HUYNH, BA

ART UNIT	PAPER NUMBER
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2179

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,299	Applicant(s) MATTHEWS ET AL.	
	Examiner Ba Huynh	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The affidavit filed on 5/30/08 under 37 CFR 1.131 is sufficient to overcome the US 5,990,890 reference. However the claimed invention is not patentable over the newly found US patent 5,796,404. See the rejection below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 69-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to provide a detail description for the claimed limitation “executing said application program in response to said second signal” and “displaying a menu responsive to said first signal, wherein said menu is displayed only after said application is executed”, i.e., how the second input signal being executed prior the first input signal. Instead, the spec clearly discloses a first signal for displaying of the menu responsive to the first signal, a second signal for executing an application selected from the displayed menu (see parent application 09/954,167, now US patent 6,724,405, claim 11 in specific). Figure 8 of the

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specification discloses displaying of “a menu” after execution of an application only in response to a determination that a final task requires the display of an appropriate menu. This menu is not the same menu requested in step 801 and is not initiated by the first signal, i.e., step 801. Rather, the “a menu” is initiated by the determination whether the final task requires the displaying of “a menu”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 58-82 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 5,796,404 (Gentner).

- As for claim 58: Gentner teaches a system for controlling computer functions, the system capable of operating in a plurality of modes including conventional mouse input mode and keyboard accelerator overlay mode (3:39-45, 5:44-57). The system comprises a first means for generating a first signal indicating that a menu (Electronic Mail System, fig. 1) should be displayed, for generating a second signal for generating an alphanumeric selection (6:12-20, 57-65), for generating a third signal indicating that an application specific function should be performed if the application is operating in the first mode (6:22-30), means

for displaying data (figs. 3,4), a third means for receiving the first, second and third signals generated by the first means, and in response to receiving the first signal to display a menu comprising choice of at least one application together with numeric accelerator, in response to receiving the second signal launching a selected application, and in response to receiving the third signal causing the launched application to perform a function pertinent to that application if the system is operated in the first mode (8:18-32. See also description of figures 7, 9).

- As for claims 59, 68: The menu of fig. 3 is displayed in a different manner as compare to the menu of figure 2 depending whether the system is in a mouse input mode or keyboard accelerator overlay input mode. Further, the “wherein” clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat ’l Ass ’n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).
- As for claim 60: It is inherently included and should be readily clear to one of skill in the art that after the system is turn on and before the first input signal is received the display screen should remain clean. Further, the “wherein” clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat ’l Ass ’n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).

- As for claim 61: Alphanumeric accelerators overlay in multi-level menu hierarchy. The overlay accelerators are removed and re-associated with different graphical objects of a nested menu (figs 3 and 4).
- As for claims 62, 63: The user may toggle from conventional mouse input mode and keyboard accelerator overlay mode by pressing ALT key (5:34-43).
- As for claim 64: The function pertinent to the launched application program is different based on the mode of the system, e.g., the scrolling function is activated differently based on whether the system in conventional mouse input mode and keyboard accelerator overlay mode. Further, the “wherein” clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat ’l Ass ’n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).
- As for claim 65: Different functions of the launched application can be activated (Figs 3, 4). Further, the “wherein” clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat ’l Ass ’n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).
- As for claim 66: The third means receives signals from the keyboard if the system is operates in the keyboard accelerator overlay mode (1:17-19, 40-43). Further, the “wherein” clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat ’l Ass ’n of

Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).

- As for claim 67: The first mode can be a Alphanumeric accelerators mode wherein a display is enhanced with overlays (“theater mode”, figs 3, 4). Further, the “wherein” clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat ’l Ass’n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).
- As for claims 69, 76: Gentner teaches a method and corresponding system for controlling computer functions comprising the steps/means for receiving a signal for displaying a menu and a signal for executing an application, the menu is displayed after the application is executed. (First embodiment: from the menu figure 3 select an application to execute. A menu is displayed in fig. 4 of the executed application. A pull down menu can also be displayed from the menu bar. Since the claims do not clearly recite the temporal order of the first and second signals, the claimed “second signal” is being interpreted as the signal for executing the application, which actually a first input signal. Further, the “wherein” clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat ’l Ass’n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).

- As for claims 70, 77: Gentner teaches associating an alphanumeric label to an application and launching the application by activating the alphanumeric label (figs 3, 4).
- As for claims 71, 75, 78, 82: It is inherently included in Gentner that the executed application can perform a function responsive to a third signal (e.g., by activating a function from the application's menus or icons. Figs 3, 4).
- As for claims 72, 79: The menu comprises at least one application (figs. 3, 4). Further, the "wherein" clause is not given weight when it simply expresses the intended result of a process step positively recited (Minton v. Nat 'l Ass 'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).
- As for claims 73, 80: Figures 3, 4 includes at least one accelerator associated with an application program.
- As for claims 74, 81: The application is launched by activating the corresponding numeric accelerator (See descriptions of figs 3, 4).

Response to Arguments

Applicant's arguments regarding the 35 USC 112-1st have been fully considered but they are not persuasive.

Remarks: The cited portion of the specification does not teach that "the menu is displayed only after said application is executed" after the first and second selection signals. The spec clearly discloses a first signal for displaying of the menu responsive to

the first signal, a second signal for executing an application selected from the displayed menu (see parent application 09/954,167, now US patent 6,724,405, claim 11 in specific). Figure 8 of the specification discloses displaying of “a menu” after execution of an application only in response to a determination that a final task requires the display of an appropriate menu. This menu is not the same menu requested in step 801 and is not initiated by the first signal, i.e., step 801. Rather, the “a menu” is initiated by the determination whether the final task requires the displaying of “a menu”.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 2179